

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the claim amendments and arguments presented herein.

Status of Claims

In the present Amendment, claim 1 has been amended. Claims 1-18 are pending in the present application.

No new matter has been added by way of the amendment to claim 1. Support for the amendment can be found in the present specification at page 12, lines 8-15.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request the Examiner to withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 102(b) and § 103(a)

Claims 1-18 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Tsukada *et al.* '220 (US 2002/0058220 A1; now U.S. Patent No. 7,189,500 B2) (see pages 4-5 of the outstanding Office Action). Applicants respectfully traverse.

In the Office Action, the Examiner cites compound "P-15" at page 7 of Tsukada in rejecting the pending claims. However, Tsukada '220 fails to disclose the instantly claimed copolymer.

Applicants initially note that anticipation requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949 (Fed. Cir. 1990) (citing *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Also, as the M.P.E.P. directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP § 2143.03.

Here, the cited Tsukada ‘220 reference does not disclose or teach all instantly claimed features. In particular, there is no disclosure in Tsukada ‘220 of the claimed copolymer, which includes a copolymer made from a styrene monomer and from a monomer having a carboxylic acid group. The polymer “P-15” (or any other similar compound) disclosed at page 7 of Tsukada ‘220 (as cited in the Office Action, paragraph 6) is outside the scope of the present invention. Tsukada ‘220 also fails to disclose a styrene monomer in combination with the monomer represented by formula (M) of the present invention. Based on the Tsukada ‘220 disclosure, Applicants further add that there is no proper reason or rationale, or even motivation or a reasonable expectation of success, to achieve the claimed copolymer that includes the claimed styrene monomer and/or the monomer with a carboxylic acid group when there is no disclosure in Tsukada ‘220 of such monomers. One of ordinary skill in the art has no guidance to achieve the present invention, and all features of the presently claimed copolymer are not disclosed in Tsukada ‘220.

The Examiner also states the motivation is found with the expectation of improved coated surface structure and stability to image formation (Office Action, paragraph 6). Applicants question the source of such cited improvement. This statement regarding motivation appears to

be based on the Examiner's personal belief and essentially constitutes improper hindsight reasoning.

Also in the Office Action (paragraph 3), the Examiner asserts that the pending claims do not have sufficient written description and/or enablement support in Tsukada '220; therefore, the claims are not entitled to the priority date of Tsukada '220 and Tsukada '220 is prior art against the claims. Applicants respectfully submit that the present invention is supported in Tsukada '220, and this finding by the Examiner is improper. Reconsideration is requested as a sufficient number of species is disclosed to support the instantly claimed formula (M). In any event, the present claim amendments distinguish over the disclosure of Tsukada '220.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez, Reg. No. 48,501, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/724,706

Docket No.: 1982-0208P

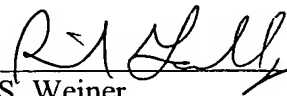
Art Unit 1795

Reply to Office Action of September 23, 2008

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: Dec. 22, 2008

Respectfully submitted,

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